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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,250	09/15/2003	Steve Sorem	72167.000547	6949

21967   7590   12/01/2011

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EXAMINER
DAGNEW, SABA

ART UNIT	PAPER NUMBER
3688	

MAIL DATE	DELIVERY MODE
12/01/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>02 November 2011</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>71-81</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>71-81</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Status of Claims

This action is in reply to the amendment filed on 13 January 2011. Claims 1-23, 25-50,

52 and 54-70 have been cancelled. Claims 71-84 have been added. Claims 71-84 are currently

pending and have been examined.

Priority

The later-filed application must be an application for a patent for an invention which is

also disclosed in the prior application (the parent or original non-provisional application or

provisional application). The disclosure of the invention in the parent application and in the later-

filed application must be sufficient to comply with the requirements of the first paragraph of 35

U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32

USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 09/456,114 fails to provide

adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112

for one or more claims of this application.

Priority date of 7 December 1999 is not given for the following claim limitations:

" account comprising a plurality of defined purses, wherein a value chaining logic

is definable for the account and each purse that comprises a hierarchy for application of

value"

"storing the non-zero value in one of the plurality of defined purses"

"wherein each of the plurality of defined pursues is capable of containing a

different non-zero value forms comprising electronic cash, micro- payments, loyalty

points, or electronic coupons".

"transfer a portion of the non-zero value in one of the plurality of defined purses

to a second purse of the plurality of defined purses."

Election/Restrictions

Applicant's election without traverse of claims 71-81 in the reply filed on 2 November

2011 is acknowledged.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 81 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention.

Claim 81 recites "processing, by at least...., transaction request comprising transaction

amount, from a merchant from the account holder" there is insufficient antecedent bases for this

limitation in the claim (see page 5, lines 6-7).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459

(1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating obviousness
      or nonobviousness.

Claims 71-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng (U.S.

Patent No. 6, 405,175 B1) in view of Jones (US Patent No., 5,623,547)

receiving, by at least one computer processor, transaction information comprising a code

pertaining to one or more qualifying products which form at least a portion of a transaction *(Fig.*

6, 142, where "user inputs URL, price, product info" reads on transaction information

comprising code and Fig, 7, teaches expected price info includes "MAKE: SUPRCOMP,

MODEL: SUPERLAP 501, reads on a code);

inspecting, by the at least one computer processor, the transaction information by

performing a comparison of the code against previously received codes *(Fig. 6, 146 teaches*

looks up URL in product database, where "looks up URL in product database" reads on

performing a comparison of the code against previously received code, and where "is URL

already in DB" reads on inspecting);

storing, electronically, the code in a database wherein the code becomes a previously

received code upon storage*(Fig. 6, teaches if the URL already in DB?, YES, 154, teaches*

checking new info if YES, storing each field for new info);

generating a credit to the account based each new candidate code wherein the credit

comprises a non-zero value *(Fig. 6, teaches if the URL already in DB, N, 148, teaches sorting*

user's info in DB, and calculate reward points, where "storing user's info and calculate reward

points " reads on generating a credit based on new candidate code, Col. 5, lines 55-60, teaches

*stabling user account when user enters new product information, **Col. 9, lines 66-67**, teaches the*

*product from this particular supplier being entered in new, and **Col. 10, lines 1-7**, teaches the*

URL product and price information is verified and loaded(stored) new); and

notifying, electronically, the account holder of the credit *(Fig. 6, 152, teaches reporting*

(notifying) submission and rewards to user) .

Ng teaches all the above element including establishing, by at least one computer

processor, an account, identified with an account holder *(Col. 5, lines 55-65, teaches*

establishing accounts by using account manager in reward and user database, when user enters

new product). Ng does not explicitly teach account comprising a plurality of defined purses,

wherein a value chaining logic is definable for the account and each purse that comprises a

hierarchy for application of value and storing the non-zero value in one of the plurality of

defined purses.

However, Jones teaches account comprising a plurality of defined purses, wherein a value

chaining logic is definable for the account and each purse that comprises a hierarchy for

application of value *(Col. 2, lines 15-31, teaches providing a value transfer system and a*

*plurality of electronic purses **and Col. 5, lines 39-59** where "a bulk purse 1c, 23, 3c which is*

connected with the respective value meter" reads on a hierarchy for application of value and

teach electronic purses which is contained in terminals located at different points-of sales) and

storing the non-zero value in one of the plurality of defined purses *(Col. 5, lines 44-54, teaches*

electronic purses in the form of IC cards, each card is stored a purse value and to load the value

in the purse). Therefore, it would have been obvious to the one ordinary skill in the art at the

time of the invention was made to include a feature that allow electronic purses to be load with

the value as taught by Jones in the system of Ng in order to allow the recipients of the account to

utilize the funds associated with the account to make a purchase or pay for goods/serve at any

location.

　　With respect to claim 72, Ng in view Jones of teaches all elements of claim 71,

furthermore, Ng teaches the method further comprising:

　　generating a certificate upon a pre-set amount of the non-zero value being accumulated in

the account*(Col. 1, lines 15-16, teaches issuing value stamps or coupon)*

　　With respect to claim 73 Ng in view of Jones teaches all elements of claim 72,

furthermore, Ng teaches the method, wherein the certificate is usable as a coupon, rebate, gift

certificate, or refund *(Col. 1, lines 15-19, teaches exchanging for a reward travelers, with free*

tickets once enough miles have been flown).

　　With respect to claim 74, Ng in view of Jones teaches all elements of claim 72,

furthermore, Ng teaches the method, further comprising:

　　receiving a redemption of the certificate *(Col. 1, lines 15-21, teaches receiving instant*

price reduction, where "receiving instant price reduction" reads on redemption of certificate).

With respect to claim 75, Ng in view of Jones teaches all elements of claim 71, except ,

wherein each of the plurality of defined pursues is capable of containing a different non-zero

value forms comprising electronic cash, micro- payments, loyalty points, or electronic coupons.

However, Jones teaches wherein each of the plurality of defined pursues is capable of

containing a different non-zero value forms comprising electronic cash, micro- payments, loyalty

points, or electronic coupons *(Col. 6, lines 58-65, teaches loading different currencies)* .

Therefore, it would have been obvious to the one ordinary skill in the art at the time of the

invention was made to include a feature that allow to load appropriate currency as taught by

Jones in the system of Ng in order to be used on an international based *(see col. 6, lines 58-65])*

With respect to claim 76, Ng in view or Jones teaches all elements of claim 71,

furthermore, Ng teaches the method further comprising:

receiving, from the account holder, a request to convert a portion of the non-zero value in

the account from a first form to a second form *(Col. 1, lines 16-19, teaches exchanging for a*

reward or discount and Col. 9, lines 25-29, teaches converting points into prize, such as bonus,

online time, special offer, etc.).

With respect to claims 77, Ng in view of Jones teaches all elements of claim 71

except receiving, from the account holder, a request to transfer a portion of the non-zero value in

one of the plurality of defined purses to a second purse of the plurality of defined purses.

However, Jones teaches receiving, from the account holder, a request to transfer a portion

of the non-zero value in one of the plurality of defined purses to a second purse of the plurality

of defined purses *(Col. 2, lines 15-19, teaches purses communicating each other to transfer*

values). Therefore, it would have been obvious to the one ordinary skill in the art at the time of

the invitation was made to include value transfer been electronic purses as taught by Jones in the

system of Ng in order to conduct cash less transactions to prevent customer from carrying the

actual cash.

With respect to claim 78, Ng in view of Jones teaches all elements of claim 71

except receiving, from an account holder, a request to transfer a portion of the non-zero value

from the account to a second account associated that is identified with a different account holder.

However, Jones teaches receiving, from an account holder, a request to transfer a portion

of the non-zero value from the account to a second account associated that is identified with a

different account holder. *(Col. 3, lines 60-61, transaction between purses and Col. 4, lines 34-*

36, teaches transferring value from the consumer's IC card to a retailer's IC). Therefore, it

would have been obvious to the one ordinary skill in the art at the time of the invitation was

made to include value transfer been electronic purses as taught by Jones in the system of Ng in

order to conduct cash less transactions to prevent customer from carrying the actual cash.

With respect to claim 79, Ng in view of Jones teaches all elements of claim 71, except

receiving, from the account holder, an identification of an order of preference for use of the non-

zero value in the plurality of defined purses.

However, Jones teaches receiving, from the account holder, an identification of an order

of preference for use of the non-zero value in the plurality of defined purses *(Col. 3, lines 1-10,*

teaches sending transaction identifier form the transmitted purse and *Col. 4, lines 40-43, identity*

of the customer to allow a transaction). Therefore, it would have been obvious to the one

ordinary skill in the art at the time of the invention was made to include a cryptographic

techniques as taught by Jones in the system of Ng in order to prevent fraudulent activities *(See Jones Col. 3, lines 11-12).*

With respect to claim 80, Ng in view of Jones teaches all elements of claim 71, except, wherein the non-zero value in each of the plurality of defined purses is capable of being used to fulfill an amount associated with a transaction.

However, Jones teaches wherein the non-zero value in each of the plurality of defined purses is capable of being used to fulfill an amount associated with a transaction *(Col. 5, lines 46-67, teaches consumer takes his goods and is free to use the card to the total held in the purse value, where "the total held in the purse value" reads on purses is capable of being used to fulfill an amount associated with a transactions).* Therefore, it would have been obvious to the one ordinary skill in the art at the time of the invention was made to include a feature that allow to load different currencies to be used on an international basis *(See Jones , Col. 6, lines 58-61).*

Claim 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (US Patent No., 5,623,547) in view of Ng (U.S. Patent No. 6, 405,175 B1)

With respect to claim 81, Jones teaches a method, comprising:

defining, at the request of an account holder, value chaining logic pertaining a plurality of defined purses comprising an account *(Col. 4, lines 1-9, teaches communication with the computer established by telephone and incorporating purses in telephone or mode to conduct transaction via telephone and electronic purses, and teaches electronic purses in the forms of IC or Smart card, key fobs, wallet or the like)* wherein the value chaining logic comprises an order

of use of non-zero value stored in each of the plurality of defined purses that uses free value

types before funded value types*(Col. 4, lines 61-62, teaches loading value records on to the*

*purses in selected currencies for use in appropriate countries, **Col. 5, lines 46-67,** teaches*

consumer takes his goods and is free to use the card to the total held in the purse value, where

"the total held in the purse value" reads on   purses is capable of being used to fulfill an amount

*associated with a transactions **and Col. 6, lines 58-65,** teaches loading different currencies)*;

processing, by at least one computer processor, a transaction request, comprising a

transaction amount, from a merchant from the account holder *(**Col. 6, lines 5-8,** where "*

requesting a redemption of value" reads on a transaction request comprising transaction

amount);

ordering, by the at least one computer processor, the plurality of defined purses based on

the value chaining logic *(**Col. 2, lines 19-20,** where "draw-down means for loading purses with*

value under control of the computer" reads on ordering by);

defining a set of filtered and ordered purses to use to fulfill the transaction amount

fulfilled *(**Col. 2, lines 19-31,** teaches draw-down (filtered and order) means for*

loading(applying) purses and redemption means for redeeming value, where "loading purses

and redemption meads for redeeming value" reads on purse used to fulfill the transaction

amount) ; and

applying, by the at least one computer processor, the value chaining logic to the

applying, by the at least one computer processor, the value chaining logic to the transaction

amount by applying, from the set of filtered and ordered purses, the non-zero value from each

purse, as specified by the value chaining logic, until the transaction amount is fulfilled *(**Col. 2,**

lines 19-31, teaches draw-down (filtered and order) means for loading(applying) purses and redemption means for redeeming value, **and Col. 5, lines 52-55,** *teaches instituting a draw-dawn of value to load purse with requested value with the value ready to be used).*

Jones teaches all the above elements including accumulating non-zero values in each of the plurality of defined purses (**Col. 2, lines 16-20,** *teaches a plurality of electronic purses and "draw-down means for loading purses with value under control of the computer*)

Jones does not explicitly teach wherein the non- zero value is accumulated, at least in part, through purchases of one or more qualifying products or services and remove purses with value types not accepted by the merchant.

However, Ng teaches wherein the non- zero value is accumulated, at least in part, through purchases of one or more qualifying products or services *(Col. 4, lines 65-66, where "rewarding consumer for supplying information about lower prices" reads on the non-zero value is accumulated for qualifying product).* Therefore, it would have been obvious to the one ordinary skill in the art at the time of the invention was made to include a feature that offers reward for qualified transaction as taught Ng in the system of Jones in order to increase customer loyalty and sales. Neither Jones nor Ng explicitly teaches remove purses with value types not accepted by the merchant.

However Jones teaches funs represented thereby being apportioned between the participating institutions as agreed on the bases of the respective regulated float files *(Col. 5, lines 1-4)* it would have been obvious to one having ordinary skill in the art at the time of the invention to remove purses with value not accepted by merchant because (for example, declining

credit card, such as, discover credit card, etc... by certain merchants) are commonly used in retail

business, so using such techniques in this manner is simply a combination of old elements that

would have performed the same function in the combination and on of ordinary kill would have

recognized that the result of the combination were predictable.

Response to Arguments

Applicant's arguments with respect to claims 71-84 have been considered but are moot in

view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SABA DAGNEW whose telephone number is (571)270-3271. The examiner can normally be reached on 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SABA DAGNEW/
Primary Examiner, Art Unit 3688